

FILE COPY

RECEIVED
JAN 19 1941
U.S. DEPT. OF JUSTICE
DIVISION OF INVESTIGATION

RECEIVED

UNITED STATES DEPARTMENT OF JUSTICE
DIVISION OF INVESTIGATION
WASHINGTON, D. C.
JAN 19 1941
RECEIVED

**BRIEF FOR RESPONDENT IN OPPOSITION
TO PETITION FOR WRIT OF HABEAS CORPUS**

✓
Dean R. Edwards,
Attorney for Respondent.

ROBERT F. McLEAN,
Partner, Edwards, McLean & Edwards,
of Counsel.

INDEX

	PAGE
Brief for Respondent in Opposition to Petition for Writ of Certiorari	1

TABLE OF CASES

Altwater v. Freeman, 319 U. S. 359	2
Chicago Forging, Etc. Co. v. Bade-Cummins Mfg. Co., 63 F. 2d 928 (C. C. A. 6)	4
Craftint Mfg. Co. v. Baker, 94 F. 2d 369 (C. C. A. 9) ..	4
Electrical Corp. v. Thomas Co., 307 U. S. 241	2
Elevator Supplies Co. v. Graham & Norton Co., 44 F. 2d 354 (C. C. A. 3)	4
E. Van Noorden Co. v. Cheney Co., 75 F. 2d 298 (C. C. A. 1)	4
Flowers v. Austin-Western Co., 149 F. 2d 955 (C. C. A. 7)	4
General Mfg. Corp. v. Gray, 48 F. 2d 602 (D. C., W. D., Okla., 10th Circuit)	4
Grubman Engineering & Mfg. Co. v. Goldberger, 47 F. 2d 151 (C. C. A. 2)	4
Henderson v. Welch Dry Kiln Co., 39 F. 2d 589 (C. C. A. 5), affirming 26 F. 2d 810	4
James R. Kearney Corp. v. Line Material Co., 95 F. 2d 299 (C. C. A. 8)	4
Sinclair Co. v. Interchemical Corp., 325 U. S. 327	2
Victor Cooler Door Co. v. Jamison Cold Storage Door Co., 44 F. 2d 288 (C. C. A. 4)	4
Westinghouse v. Boyden Power Brake Co., 170 U. S. 537	4

OPINIONS BELOW

District Court, D. Maryland (Coleman, D. J.), 60 F. Supp. 533	
Circuit Court of Appeals, Fourth Circuit (per Dobie, C. J.), 155 F. 2d 6	

IN THE
Supreme Court of the United States

OCTOBER TERM, 1946

No. 515

WHEELING STAMPING COMPANY and
BURRASON CORPORATION,

Petitioners,

v.

STANDARD CAP AND MOLDING COMPANY,

Respondent.

**BRIEF FOR RESPONDENT IN OPPOSITION
TO PETITION FOR WRIT OF CERTIORARI**

Respondent submits that the petition herein presents no question calling for the grant of a writ of certiorari and should be denied.

Petitioners' statement of the "questions raised by the case" and the "reasons relied on for allowance of the writ" is obscure, erroneous and repetitious. All of Petitioners' numerous "questions" and "reasons" fall within one or the other of two propositions.

First, Petitioners say that while the trial court proceeded in an orderly and judicial manner through a trial extending over most of three days to a finding of non-infringement, it did not permit, but should have permitted, the prolongation of the trial to include a full inquiry into the validity of the three patents in suit. The course which the trial court

followed was in full accord with the most pertinent decisions of this Court which are:

Electrical Corp. v. Thomas Co., 307 U. S. 241;
Altwater v. Freeman, 319 U. S. 359;
Sinclair Co. v. Interchemical Corp., 325 U. S. 327.

Had the trial court admitted full evidence on the validity of the three patents and been led by that evidence to conclude that one or more of the patents was a valid patent but not infringed, it could not have included the finding of validity in its decree. The *Thomas* and *Altwater* cases forbid that.

Had the trial court admitted such full proofs and been led thereby to a conclusion of invalidity of one or more of the patents and no infringement of any one of them, it could have included in its decree its finding of invalidity as well as its finding of non-infringement. That would have been "the better practice" under this Court's precept in the *Sinclair & Carroll* case (325 U. S. 330), but that course has not been prescribed, doubtless with the intent of leaving it within the discretion of the trial court to follow that "better practice" or not as the circumstances of each case do or do not make that course appropriate.

Second, Petitioners assert that, in deciding the issue of infringement, the lower courts proceeded contrary to those cases in this and other courts which state the rule that the claims of a patent measure the scope of protection to be accorded to the patent. No such conflict exists. All of the cases cited by Petitioners recognize that the fundamental rule on the issue of infringement is that there is infringement only when the accused machine involves appropriation of the actual invention of the patent, and they recognize that the question of infringement is one of substance and not one of words. They state that the claims of a patent are the measure of the monopoly of the patentee, and are not to be twisted, deformed or expanded by refer-

ence to the specification. None, however, holds or suggests that the claims of a patent are to be considered in a vacuum, without reference to the actual invention of the patentee as set forth in his specification and drawing, or so interpreted as to include subsequent devices wholly different in structure or operation from anything described or suggested in the patent. There is no case holding that broad, nebulously worded claims are to be considered, on the issue of infringement, without reference to the substance of the invention.

In this case, the lower courts, in considering the question of infringement, carefully analyzed the Rahm patent to determine what is the alleged invention as it is described or suggested in the patent. To assist them in this, the courts had the benefit of Rahm's full testimony, both as to what is described or suggested in the patent and as to its relationship to the accused Stokes machine. All four of the Judges who passed upon the case concluded that the Stokes machine differs so widely in structure and operation from what is described or suggested in the patent as to afford no basis for a conclusion that the Stokes machine involves appropriation of the alleged invention of the patentee, and therefore decided that there was no infringement.*

Petitioners would have the issue of infringement decided, not as the courts below decided it on the basis of the substance involved, but by a mere reading of the nebulous wording of the claims of the patent without their interpretation in the light of the substance of the alleged invention.

* That the Stokes machine owes nothing to the patent, and is neither described nor suggested therein is plain. Indeed, Rahm, the patentee, testified that description of a machine of the Stokes type was deliberately omitted from the patent to permit him to obtain subsequent patents thereon "in order to extend the life of this patent" (R. 65a), presumably to his advantage and to the public detriment. A patent cannot be construed to cover matters purposefully omitted in an effort to avoid the limitation of the patent monopoly to the statutory period of seventeen years.

Petitioners refer to no case in which that course was followed or approved and cannot do so.

We know of no case, and Petitioners have cited none, in which a court has found infringement without finding an appropriation of what is described or suggested as the invention of the patent.

The procedure of the lower courts in this case having been in conformity with the well-established practice and being in conflict with neither decisions of this Court nor decisions of any Court of Appeals, there appears to be no reason why this Court should review the case. Pertinent cases showing that this is the established practice in this Court and in the courts of every circuit include:

- Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537;
E. Van Noorden Co. v. Cheney Co., 75 F. 2d 298 (C. C. A. 1);
Grubman Engineering & Mfg. Co. v. Goldberger, 47 F. 2d 151 (C. C. A. 2);
Elevator Supplies Co. v. Graham & Norton Co., 44 F. 2d 354 (C. C. A. 3);
Victor Cooler Door Co. v. Jamison Cold Storage Door Co., 44 F. 2d 288 (C. C. A. 4);
Henderson v. Welch Dry Kiln Co., 39 F. 2d 589 (C. C. A. 5), affirming 26 F. 2d 810;
Chicago Forging, Etc. Co. v. Bade-Cummins Mfg. Co., 63 F. 2d 928 (C. C. A. 6);
Flowers v. Austin-Western Co., 149 F. 2d 955 (C. C. A. 7);
James R. Kearney Corp. v. Line Material Co., 95 F. 2d 299 (C. C. A. 8);
Craftint Mfg. Co. v. Baker, 94 F. 2d 369 (C. C. A. 9);
General Mfg. Corp. v. Gray, 48 F. 2d 602 (D. C., W. D., Okla., 10th Circuit).

The petition should be denied.

Respectfully submitted,

DEAN S. EDMONDS,
Attorney for Respondent.

ROGER T. McLEAN,
PENNIE, EDMONDS, MORTON & BARROWS,
of Counsel.